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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,592	01/14/2002	R. Michael Gross		3738
7590	01/14/2004		EXAMINER	
Dennis L. Thomte THOMTE, MAZOUR & NIEBERGALL, L.L.C. Suite 1111 2120 South 72nd Street Omaha, NE 68124			PELLEGRINO, BRIAN E	
			ART UNIT	PAPER NUMBER
			3738	8
			DATE MAILED: 01/14/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/046,592	GROSS, R. MICHAEL
	Examiner	Art Unit
	Brian E Pellegrino	3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 January 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8

- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other:

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "tube having an arcuate portion" must be shown or the feature(s) canceled from the claim(s). The figures show an "angular portion". No new matter should be entered.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1,2,4 are rejected under 35 U.S.C. 102(b) as being anticipated by Angsupanich (5197949). Fig. 3 shows an elongated, hollow tube 1 with a plurality of

openings **12** at its distal end **3**. Angsupanich discloses the proximal end **2** is placed in communication with a suction mechanism, col. 2, lines 24-26. It can also be seen that the distal end has an angular portion. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. Clearly, the device is capable of having its length and diameter such that its distal end may be positioned in the glenoid vault.

Claims 1-3,5,6 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. (5693030). Fig. 1 shows an elongated, hollow, rigid tube **20** with an arcuate distal portion **38** having a plurality of openings **32** therein. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. Clearly, the device is capable of having a length and diameter such that its distal end may be positioned in the glenoid vault. Fig. 3 shows an obturator **60** that may be extended in the tube that is fully capable of clearing debris. Lee et al. disclose that a sleeve is slidably mounted on the tube, col. 9, lines 32-36. Lee also discloses the tube can be aspirated or in other terms "communication with a suction device", col. 9, lines 36-38, col. 11, lines 47,48.

Claims 1,3,6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Dubinsky (WO 99/52441). Fig. 1A shows an elongated, hollow tube **120** with an arcuate portion at its distal end and sealing means **132** thereon. Dubinsky discloses the proximal end is placed in communication with a suction mechanism **143**, page 12, lines 22,23. Dubinsky also discloses the tissue removing device is inserted in bone cavities, page 10, lines 28-30. Dubinsky additionally discloses the sealing means is used to seal

a passage to help retain body material, page 12, lines 8-10,18-20. Dubinsky shows (Fig. 2) an elongated sleeve 112 slidably mounted on the tube. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. Clearly, the device is capable of having its length and diameter such that its distal end may be positioned in the glenoid vault.

Response to Arguments

Applicant's arguments filed 7/7/03 have been fully considered but they are not persuasive. In response to applicant's argument that Angsupanich and the Lee et al. references teach suctioning devices for different uses, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3738

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8:30am to 6pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

TC 3700, AU 3738

Brian E. Pellegrino



BRUCE SNOW
PRIMARY EXAMINER